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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Appln. of: FANEUF  
Serial No.: 09/723,868  
Filed: November 28, 2000  
For: COMBINATION ROPE AND CLIP FOR CULLING FISH  
Group: 3644  
Examiner: SMITH, KIMBERLY S. DOCKET: FANEUF 00.02

MAIL STOP APPEAL BRIEF - PATENTS  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**TRANSMITTAL LETTER**

Dear Sir:

In connection with the above-entitled matter, enclosed please find Appellant's Reply Brief under 37 C.F.R. 1.193(b), in triplicate.

In the event there are any fee deficiencies or additional fees are payable, please charge them (or credit any overpayment) to our Deposit Account No. 08-1391.

Respectfully submitted,

Norman P. Soloway

Attorney for Appellant

Registration No. 24,315

**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP - APPEAL BRIEF PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 7, 2004 at Tucson, Arizona.

By Natalie Mishalane

NPS/JBK:nm

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567



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**APPELLANT'S REPLY BRIEF  
UNDER 37 C.F.R. 1.193(b)**

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

---

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567



Serial No. 09/723,868  
Docket No. FANEUF 00.02  
APPELLANT'S REPLY BRIEF UNDER 37 CFR §1.193(b)

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HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

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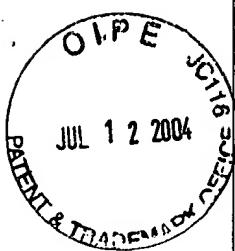
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**HAYES SOLOWAY P.C.**  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567



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**APPELLANT'S REPLY BRIEF UNDER 37 CFR § 1.193(b)**

This Reply Brief is being filed in response to the new points of argument raised in the Examiner's Answer mailed May 12, 2004. Appellant responds to these new points of argument, as follows.

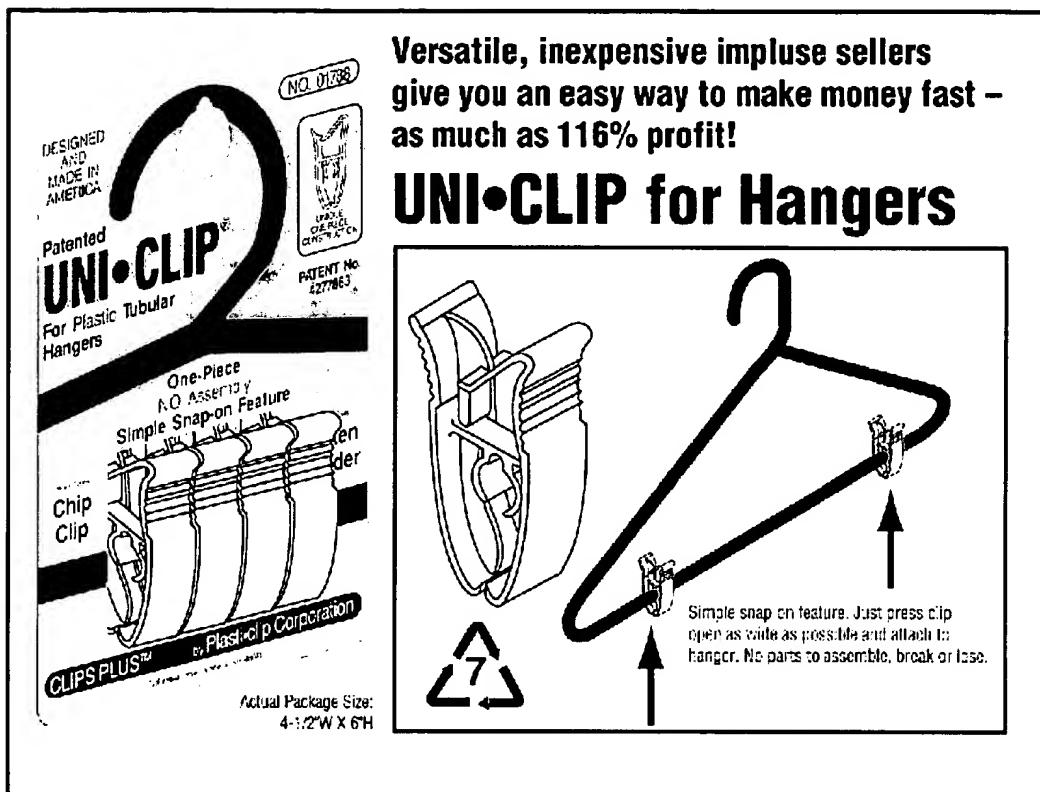
**THE REJECTION OF CLAIMS 1, 2, 4, 5, 7, 8, 10-13, 15-17,  
AND 19-22 UNDER 35 U.S.C. § 103(a) AS UNPATENTABLE  
OVER JOHNSON (U.S. PATENT NO. 6,044,582) IN VIEW  
OF THE ADMITTED PRIOR ART (APA) IS IMPROPER.**

**A. Johnson, Standing Alone or in Combination with the APA  
Cannot Achieve or Render Obvious Appellant's Invention.**

Johnson merely teaches attaching a rope to a "hook" to achieve a fish culling device. The "hook" is not a clip consistent with the detailed limitations as set forth in Appellant's independent claims 1, 12 and 21. For example, the "hook" in Johnson is not a molded plastic

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567



(<http://www.plasticclip.com/pclip/pop21.htm>)

In refuting Appellant's claim that the clip taught in the prior art is a garment hanger, the Examiner merely notes that the clips are packaged individually and not attached to a garment hanger. This is insufficient to meet the Examiner's *prima facie* burden for obviousness. There is absolutely no teaching or suggestion that the prior art clip be used for culling fish. Furthermore, the packaging of the prior art clip (shown above on the left) contains the phrase "For Plastic Tubular Hangers". It also clearly depicts an image of a plastic tubular hanger passing through the clip at the point where the clip attaches to the hanger. Additionally, a second image of a hanger is shown (above, right) and teaches how the prior art clip is designed

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

—  
175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

clip having first and second arms coupled to and rotatable about a spacer. The arms are not urged upward by a biasing member to create a gripping force. There is not a protrusion extending from the spacer to prevent the fish from being inserted too far on the clip. (Appellant's claim 1). Furthermore, the "hook" as depicted in Johnson requires a hole to be punctured in the mouth of the fish to attach the device. (see Johnson, Fig. 2, item 32). This teaches away from Appellant's claimed invention, which was designed specifically to solve the problem of puncturing a hole in the fish. (Appellant's Brief, p. 3, first full paragraph).

The Examiner states in the Examiner's Answer that "The inventive idea surrounding the Johnson reference is the manner in which a culling rope is created and not to [sic] the design of the clip for which the rope is to be applied." (Examiner's Answer, p. 3, cipher 11, para. 1). This admission places the burden on the Examiner to show other prior art references that teach or suggest the Appellant's claims that are missing in the Johnson reference. The prior art when combined must teach or suggest *all* the claim limitations. (M.P.E.P. § 2142; see also *In re Royka*, 490 F.2d 981 (CCPA 1974)). Appellant's claims are directed to the confirmation of a clip and a rope, not just a clip or a rope. Needless to say, the Examiner cannot make out a case for obviousness by ignoring essential claim limitations.

The Examiner states in the next paragraph "Attention is respectfully drawn to the submitted prior art dating at least as early as 1998, entitled 'Plasti-Clip HANG UPS' in which the prior art clip is shown to be sold as an individual item and not in conjunction with the hanging mechanism." (Examiner's Answer, p. 3, cipher 11, para. 2). The image below is reproduced from prior art entitled "Plasti-Clip HANG-UPS":

HAYES SOLLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

to be attached to the plastic tubular hanger for hanging clothing. This clearly teaches away from Appellant's claimed invention. There is no suggestion as to how the prior art clip can be used in conjunction with Johnson to achieve a fish culling device that would render claimed invention obvious. Such a teaching or suggestion is required for a proper obviousness rejection under 35 U.S.C. § 103(a). (M.P.E.P. § 706.02(j); see also *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991)). Even if the combination of all the references taught every element of the claimed invention, a rejection based on obviousness is improper without a showing of a motivation to combine. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Continuing the erroneous reasoning that the prior art clip is not a garment hanger, the Examiner states that combining the prior art clip with device taught by Johnson would be obvious to anyone skilled in the art. (Examiner's Answer, p. 3, last para. to p. 4, continuing para.) However, the level of skill in the art cannot alone provide the suggestion to combine the references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999). "In other words, the examiner *must show reasons* that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner described." (*Rouffet* at 1358, emphasis added). The only reasoning offered by the Examiner is that "anyone skilled in the art would be capable discerning that a clip, irrespective of prior use, would be expected to function *in a manner previously known . . . irrespective of what was being clipped.*" (Examiner's Answer, p. 4, lines 1-4, emphasis added).

This statement demonstrates the Examiner's lack of understanding of the novelty of the device. The prior art clip as used in the claimed invention does not "function in a manner

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

previously known". In the manner previously known, the prior art clip is attached to a plastic tubular hanger at spacer 110 (Appellant's Brief, p. 8, fig. 2; see also "Plasti-Clip HANG UPS document *supra*). Used in the manner previously known, there is no upward force on the biasing member 116. (Appellant's Brief, p. 4, Figure 4). Therefore the gripping force is a constant material property of the clip. It does not increase in proportion with the weight of the hanging garment.

A feature of the claimed invention lies in the strategic placement of the loop of rope such that it exerts a force on the biasing member 116. Any tension in the rope exerts a force on the biasing member which increases the gripping force of the clip beyond its gripping force when it is used in the manner previously known. When a weight is hanging from the claimed invention, the tension in the rope acts as a force pulling the biasing member in the upward direction (against gravity). This causes an upward motion of the biasing member which urges the upper portions of the clip to move away from each other in a direction that is perpendicular to the tension in the rope. The spacer 114 acts as a fulcrum and motion of the upper portions away from each other increases the force pushing the lower protrusions 136 and 138 of the clip toward each other. The force pushing the lower protrusions 136 and 138 of the clip together is the gripping force of the clip. Moreover, this gripping force increases in proportion with the weight of the fish. (Appellant's Brief, p. 3, first paragraph of Summary of Invention on Appeal). This gripping force does not increase when the prior art clip is "used in a manner previously known". The Examiner has shown no reasoning why a person skilled in the art would use the prior art clip in this novel manner *that is independent of the Appellant's disclosure*. The Examiner's reasoning relies on the use of the prior art clip "in a manner

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

previously known". Thus there is no *prima facie* showing that the prior art supplies the admitted missing teachings regarding clip design to Johnson that would render Appellant's claimed invention obvious to one skilled in the art.

The Examiner continues to misunderstand the mechanics of the claimed invention. The discussion in the preceding paragraph is reflected in the Appellant's Brief. "Even if a rope were attached, the ability of the rope to increase the gripping force of the garment would not be obvious. The weight of the clothes hung on the garment clip would be borne by the hanger, not the rope, and therefore any additional gripping force would go unheeded." (Appellant's Brief, p. 9, last line to p. 10, lines 1-3). In response, the Examiner equates the gripping force of the claimed invention to the reaction force due to gravity. If this statement were true, then a book would be "gripping" a pencil that rests on top of it. And the act of lifting the book would increase the gripping force on the pencil. This analysis is obviously in error.

When the fish is suspended by a fisherman grasping the claimed culling device, the gripping force acting on the fish is *perpendicular* to the reaction force due to gravity. The reaction force is applied to the biasing member of the clip, *not the fish*. This is what increases the gripping force. The fish is suspended as a result of frictional forces that act perpendicular to the gripping force, and in opposition to the downward weight of the fish. As a result, the claimed invention can suspend the fish *without* puncturing its mouth. The Examiner's analysis attempts to equate the claimed invention to the teachings in Johnson, wherein a hook is passed through the gills or a hole punctured in the side of the fish's mouth. The fish is suspended by a static equilibrium between the downward weight of the fish and the upward reaction force of the hook passing through the tissue of the fish. This reaction force acts on the tissue and bone

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

of the fish. Equilibrium will be reached when the tissue or bone is of sufficient strength to balance the reaction force. Weaker tissue or bone will be torn or broken as the hook passes upward through it until the hook "catches" inside the fish and an equilibrium can be reached. This is one of the disadvantages that is described in the background of the Appellant's invention and represents one of the problems that the novelty in the claimed invention solves. This is another reason why Johnson fails to render the claimed invention obvious.

The Examiner states that the gravitational force increases for any instance in which an object attached to a rope is being raised. (Examiner's Answer, p. 4, first full paragraph). This statement is in error since the gravitational force acting on an object of constant mass close to the earth does not increase (or decrease). The Examiner is likely referring to the force that is required to set overcome inertia when setting an object at rest in motion. However, the Examiner is inappropriately using dynamic mechanical analysis to form her argument. The increase in gripping force achieved by the claimed invention is a result of static mechanical analysis. When a fish is hanging from the claimed invention and *not in motion* the gripping force is increased beyond the gripping force of the clip when used in the previously known manner. To say that this is true for any object hanging from a rope is erroneous. First, a rope does not exert a gripping force as discussed at length *supra*. Second, the reaction force of an object resting or hanging on another does not change unless the objects are move. Thus the increase in reaction force that results from setting an object in motion (raising the rope) is not germane to a discussion regarding the increase in gripping force generated by the claimed invention.

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

**B. Yaman Does Not Supply the Missing Teachings to Johnson To Achieve or Render Obvious Appellant's Invention, and Yaman Is not a Proper Reference To Support a Rejection Under 35 U.S.C. 103(a).**

The Examiner alludes to Yaman (J.P. No. 0369846) to support her assertion that it would be obvious to a person skilled in the art to combine the prior art clip with the teachings in Johnson. This is in error for several reasons. Yaman does not supply the missing teachings regarding clip design to Johnson that would render Appellant's claimed invention obvious to one skilled in the art. The device taught by Yaman does not have a biasing member and is not capable of increasing the gripping force of a fish culling device in proportion with the weight of the fish. Yaman does not supply any suggestion or teaching to secure a length of rope to the clip, such that the rope would exert a force on the biasing member thereby increasing the gripping force as required by the claimed invention. The combination of Yaman and Johnson cannot achieve or render obvious the claimed invention.

Moreover, the Examiner's reference to Yaman at this stage of the proceedings is believed to be in error. While Yaman admittedly was applied in the earlier prosecution, no mention of Yaman was made in the Final Action which forms the basis of the current Appeal. Rather, in her rejection of the claims under 35 U.S.C. § 103(a), the Examiner solely relies on the APA to supply the missing teachings to Johnson, which is insufficient for reasons discussed *supra*. (Final Action, p. 4, cipher 8). "Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection." *In re Hoch*, 428 F.2d 1341, 1342 (CCPA 1970). Therefore Yaman cannot be used to supply the admitted missing teachings to Johnson to form a proper claim rejection under 35 U.S.C. § 103(a).

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

—  
175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567

The Examiner has not shown any suggestion or motivation taught *in the references* to use a garment hanging clip with a biasing member to achieve an improved fish culling device. “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is no reference in any of the prior art to a clip with a biasing member. Nor is there any reference to attaching a loop of rope to this biasing member to increase the gripping force of the culling device. The Examiner must be relying on teachings in the Appellant’s disclosure in attempting to render the claimed invention obvious. Appellant has argued that this is improper hindsight reasoning. (Appellant’s Brief, p. 7-8). The Examiner responds, citing *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (C.C.P.A. 1971):

... any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made.

(Final Action, p. 4, last paragraph).

However, the Court of Customs and Patent Appeals continues in *McLaughlin*,

A patentable invention within the ambit of 35 U.S.C. § 103, may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.

*McLaughlin* at 1395-1396, citing *In re Sponnoble*, 405 F.2d 578 (C.C.P.A. 1969).

The U.S. Court of Appeals for the Federal Circuit adds:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567



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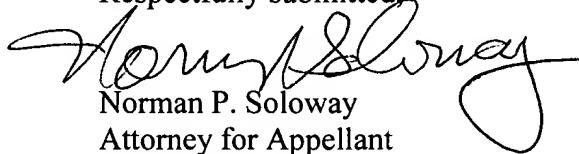
obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

*In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The Examiner has not taken to account only knowledge which was within the level of ordinary skill at the time of the claimed invention was made. There is no reference that suggests a manner in which a garment hanger clip could be used to achieve a fish culling device that results in an increased gripping force. And there is no teaching that the clip have a biasing member to achieve this increased gripping force. The Examiner is improperly using hindsight in light of the Appellant's teachings to render the claimed invention obvious.

### CONCLUSION

For the foregoing reasons and reasons previously proffered, the art rejections are in error.

Respectfully submitted,

  
Norman P. Soloway  
Attorney for Appellant  
Reg. No. 24,315

### CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: MAIL STOP APPEAL BRIEF - PATENTS, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on July 7, 2004, at Tucson, Arizona.

By 

NPS/JBK:nm

HAYES SOLOWAY P.C.  
130 W. CUSHING STREET  
TUCSON, AZ 85701  
TEL. 520.882.7623  
FAX. 520.882.7643

175 CANAL STREET  
MANCHESTER, NH 03101  
TEL. 603.668.1400  
FAX. 603.668.8567